

REMARKS

Claims 6-9, 11-14, 21-25, 27 and 31-37 are all the claims pending in the application.

Upon entry of the present Amendment, claims 6, 11, 22, 27 and 31-35 are amended. No new matter is presented.

To summarize the Office Action, claims 6, 7, 11-14, 22-23, 27, and 31-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent No. 5,963,521, hereinafter “Nagashima”), claim 21 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Belknap et al. (U.S. Patent No. 5,586,264, hereinafter “Belknap”), and claims 8 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashima in view of Hetzler (U.S. Patent No. 5,682,273). Further, claims 9, 25, 36 and 37 are allowed. The outstanding rejections are addressed below.

Claim Rejections - 35 U.S.C. § 102(e)

Claims 6, 7, 11-14, 27, and 31-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima. Applicant respectfully traverses these rejections.

Independent claims 6, 22, 31 and 32

Claims 6, 22, 31 and 33 respectively define an information recording and reproducing apparatus comprising, *inter alia*, controlling the second reproducing device and the recording device so as to simultaneously record a portion of the audio information to the second information record medium at the set recording speed and reproduce another portion of the audio information by reproducing the another portion of the audio information from the second

information record medium at the set reproducing speed. Applicant submits that Nagashima fails to teach or suggest *at least* this feature.

For instance, Nagashima merely teaches a disc recording and reproducing apparatus in which a first unit is devoted to playback and a second unit which provides recording and/or reproducing, wherein signals reproduced from the unit devoted to playback are recorded by the recording system of the recording and/or reproducing unit. *See* Nagashima at col. 3, lines 34-46. As shown in Figure 1, the recording and/or reproducing unit is depicted in the bottom of the figure (i.e., at optical disc 2 and optical head 3) while the devoted playback unit is depicted at the top of the figure (i.e., at optical disc 32 and optical head 33). *See* Nagashima at col. 4, line 21-45 and col. 8, line 9-38. Thus, Nagashima teaches that a dubbing operation is performed by reproduction of a first disc from the devoted playback unit and recorded the data from the first disc at the recording and/or reproducing unit in either high speed dubbing or ordinary speed dubbing. *See* Nagashima at col. 12, lines 13-14.

However, as Nagashima teaches that the data is recorded on an optical disc at the recording and/or reproducing unit at the same speed that the devoted playback unit reproduces a first disc, Nagashima clearly cannot be relied upon to teach simultaneously recording a portion of the audio information to the second information record medium at the set recording speed and reproduce another portion of the audio information by reproducing the another portion of the audio information from the second recording medium at the set reproducing speed, as claimed. For instance, Nagashima does not teach that data recorded to the optical disk at the recording and/or reproducing unit is simultaneously reproduced by the recording and/or reproducing unit. Rather, the only reproduction that occurs during the dubbing process involves reading data from

the disc at the devoted playback unit. In this regard, Applicant notes that Nagashima teaches that the audio data is monitored during high-speed dubbing by decoding audio data by decoder 41, memory 42 and ADPCM decoder 43. *See* Nagashima at col. 12, lines 46-58. However, as seen in Figure 1, decoder 41, memory 42 and ADPCM decoder 43 are provided at the devoted playback unit, which the Examiner analogizes to the first reproducing device.

Further, Applicant notes the Examiner contends that the data stored in the magneto/optical disc 2 can be accessed as randomly desired and refers to column 4, lines 32-34 of Nagashima. *See* Office Action at page 2. However, this passage merely refers to the process of recording data to the disc, in which a modulation magnetic field consistent with recording data is applied at the same time a track is irradiated with laser light “to effect thermomagnetic recording in accordance with the magnetic field modulation system.” *See* Nagashima at col. 4, lines 30-37. Thus, this passage suggests nothing about random access, nor does it suggest any simultaneous recording or reproduction of audio information in the manner claimed.

In view of the foregoing, Nagashima clearly fails to suggest all the features of claims 6, 22, 31 and 33, and reconsideration and withdrawal of the rejections are requested. Further, claims 7-8 and 23-24 are believed to be allowable at least by virtue of depending from claims 6 and 22, respectively. Therefore, allowance of claims 7-8 and 23-24 is likewise requested.

Independent claims 33-35

Independent claims 33-35 respectively recite the feature of a controlling device for controlling the first reproducing device and the second reproducing device to simultaneously reproduce the audio information in a non-compressed form from the first reproducing device faster than normal speed, record the audio information in a compressed form, which is converted from the non-compressed form by a compressing device, and reproduce the audio information in the compressed form from the second reproducing device at normal speed for playback.

Applicant submits that Nagashima fails to teach or suggest at least this feature.

As noted above with respect to claims 6, 22, 31 and 33, Nagashima teaches that the audio data is reproduced by the devoted playback unit and recorded by the recording and/or reproducing unit in the dubbing operation. As further demonstrated above, there is no suggestion that the recording and/or reproducing unit simultaneously records and reproduces audio information that is recorded to optical disc 2.

Therefore, Nagashima fails to suggest at the feature of the controlling device, as claimed. Accordingly, reconsideration and withdrawal of the rejection of claims 33-35 is requested.

Independent claims 11 and 27

Claims 11 and 27 respectively recite the feature of “on said second information record medium, map information including map data of at least one territory to control a navigation function for a vehicle is further recorded, said information recording and reproducing apparatus further comprises a navigation device for controlling the navigation function by using the map information, and said second reproducing device reproduces the map information during the

recording of said audio information by said recording device.” Applicant respectfully submits that Nagashima cannot properly be relied upon to teach or suggest *at least* these features.

For instance, claims 11 and 27 require that map information including map data of at least one territory to control a navigation function for a vehicle is recorded. In contrast, the “map information” the Examiner relies on in Nagashima is merely “subcode information such as header and linking sectors” of the optical disk itself. *See* Office Action at page 7. Nowhere does Nagashima suggest a navigation function for a vehicle or map information including map data, as claimed. Rather, Nagashima merely teaches dubbing of audio from a first optical disc to a recording/reproducing unit.

Consequently, Nagashima fails to suggest reproducing map information, as claimed, during recording of audio information by the recording device. As discussed above, Nagashima merely teaches that the recording/reproducing device records audio data which is reproduced by the devoted playback unit.

Therefore, Nagashima clearly fails to teach or suggest at least these features of claims 11 and 27. Accordingly, reconsideration and withdrawal of the rejection of claims 11 and 27 is requested.

Independent claim 12

Claim 12 recites, *inter alia*, the feature of a controlling device for controlling the recording device to record the audio information, which is reproduced from the first information record medium by the first reproducing device, when the audio information is outputted as a sound and also controlling the second reproducing device to reproduce and output the audio

information as the sound; and the audio information is reproduced from the second information record medium and recorded on the second information recording medium at the same time.

Applicant submits that Nagashima fails to teach or suggest at least this feature of claim 12.

As discussed above with respect to claims 6, 22, 31 and 33, Nagashima does not suggest that the recording/reproducing unit, which the Examiner analogizes to the claimed second information recording medium, records and reproduces audio information at the same time. Rather, as clearly demonstrated, the audio is only reproduced by the devoted playback unit during the dubbing process.

Further, Applicant notes the Examiner's contention that "Nagashima teaches that audio can be output from the decoder 21 while it is recorded (Fig. 1)." *See* Office Action at page 3. This contention is clearly inaccurate, as evidenced by the foregoing discussion. Indeed, Nagashima clearly teaches that audio is monitored during dubbing by decoder 41, which provides audio output at terminals 46. *See* Nagashima at col. 12, lines 46-50. Thus, Nagashima teaches that the audio is output by the decoder 43 of the devoted playback unit, not the decoder 21 of the recording/reproducing unit.

In addition, the Examiner contends that "this feature is commonly used in the practice of burning a music CD with a PC computer" and "[o]ther common uses of the above feature, for example, can be found in a multimedia on demand application." *See* Office Action at page 3. Applicant notes that these comments appear in the Examiner's response to arguments, and do not form the basis of the grounds of rejection, as applied. Further, these statements are merely the Examiner's opinion and therefore do not establish what was known at the time of invention by Applicant. To the extent that the Examiner may rely on such allegations in the form of Official

Notice in a subsequent rejection, Applicant respectfully requests that the Examiner provide evidence that the recited features were “well-known”.

Accordingly, as Nagashima clearly cannot be relied upon to teach or suggest all the recited features of claim 21, reconsideration and withdrawal of the rejection is requested.

Claim Rejection - 35 U.S.C. § 102(b)

As noted above, claim 21 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Belknap. Applicant respectfully traverses and submits that Belknap cannot properly be relied upon to teach all the features of claim 21. For instance, claim 21 recites, *inter alia*, the features of the audio information is recorded in the first information record medium in a compressed state based on a first compressing method, the recording device records the audio information in a compressed state based on a second compressing method, which is different from the first compressing method, into the second information record medium, and the audio information is reproduced from the second information record medium and recorded on the second information recording medium at the same time.

In the grounds of rejection, the Examiner alleges that elements 160 and 162 of prior art Figure 12 correspond to the claimed “reproducing device for reproducing audio information from a first record medium, in which audio information is recorded.” Further, the Examiner points to the background discussion of Belknap at col. 1, lines 37-40, and concludes that elements 160 and 162 refer to a “VHS tape” which allegedly stores movies including audio files. Applicant respectfully disagrees with the Examiner’s interpretation. Indeed, the prior art Figure 12 does not teach that movies are stored on VHS tape, but instead refers to a prior art technique of

splitting a video “between two disk files 160, 162” which Belknap teaches “cannot ensure isochronous delivery of video data to a user.” *See* Belknap at col. 22, line 42 - col. 23, line 29.

Further, the Examiner alleges that element 16 Figures 1 and 1C of Belknap corresponds to the recited recording device for recording the reproduced audio information into a second recording medium, which the Examiner identifies as element 45. In addition, the Examiner contends that the second recording medium is “a DVI tape of DVD disc with MPEG format.” *See* Office Action at page 11. However, Belknap teaches a headend disk storage node 16 in a distribution network which includes a plurality of disks 45 “spreading the data across the disks in a quasi-RAID fashion.” *See* Belknap at col. 7, lines 53-63. Thus, a RAID array of storage disks in a storage node cannot properly be interpreted as a “DVI tape or DVD disc”.

Therefore, not only is there no logical relationship disclosed between the prior art video splitting disclosed by Figure 12 and the storage node of Figures 1 and 1C, Belknap clearly does not teach that a VHS tape is recorded to a DVI tape or DVD disk, as the Examiner alleges. Rather, Belknap merely provides a Video On Demand architecture in which a selected video is stored as a plurality of blocks and reproduced from a storage node, which buffers at least one of the blocks in order to stream the video to a viewer. *See* Belknap at col. 3, lines 16-48. Thus, the Examiner’s contention that “audio is reproduced while the user is recording of the audio to the DVI or MPEG disc; user watching multimedia while it is being recorded” is clearly not supported by Belknap.

Moreover, the Examiner alleges that a VHS tape storing video in an NTSC format corresponds to the claimed “first compressing method.” This assertion is likewise factually inaccurate. The NTSC “National Television Standards Committee” standard is well known as an

analog video broadcast standard in picture information is transmitted in AM (amplitude modulation) and sound information is transmitted in FM (frequency modulation). NTSC does not, however, include any compression of audio information. Rather, the audio is merely stored in a modulated form on the tape. Thus, the Examiner's reliance of an NTSC VHS tape as a "first compressing method" is improper.

As a result, Belknap cannot properly be relied upon to teach at least the features of the audio information is recorded in the first information record medium in a compressed state based on a first compressing method, the recording device records the audio information in a compressed state based on a second compressing method, which is different from the first compressing method, into the second information record medium, and the audio information is reproduced from the second information record medium and recorded on the second information recording medium at the same time. Accordingly, reconsideration and withdrawal of the rejection is requested.

Claim Rejections - 35 U.S.C. § 103

Claims 8 and 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nagashima in view of Hetzler. Without commenting substantively on the grounds of rejection, Applicant submits that claims 8 and 24 are allowable at least by virtue of depending from claims 6 and 22, respectively.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Brian K. Shelton
Registration No. 50,245

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: October 31, 2005